

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:

John E. Jones

Customer No. 41230

Patent No. 7,647,275 B2

Confirmation No. 2932

Issued: January 12, 2010

Art Unit: 3691

For: AUTOMATED PAYMENT SYSTEM AND
METHOD

Examiner: Lalita M. Hamilton

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Mail Stop Patent EXT. – via EFS
COMMISSIONER FOR PATENTS
Alexandria, Virginia 22313-1450

Dear Commissioner:

Pursuant to 37 C.F.R. § 1.705(d), Applicant requests reconsideration of the patent term adjustment (“PTA”) indicated on U.S. Patent No. 7,647,275 B2, which issued on January 12, 2010, from Application No. 09/899,727. The PTA printed on the patent is 1,756 days. **Applicant believes that the correct PTA is 2,425 days.** This Request for Reconsideration of Patent Term Adjustment is being filed within two months of the issuance of the patent, and is thus timely. *See* 37 C.F.R. § 1.705(d). Because the appropriate PTA under 37 C.F.R. § 1.702(b) could not be calculated until the issuance of the patent, Applicant could not have raised the following issue in an application for PTA under 37 C.F.R. § 1.705(b).

The fee set forth in 37 C.F.R § 1.18(e) is submitted concurrently herewith.

I. The Corrected PTA And Support From 37 C.F.R. § 1.702

Applicant is entitled to a PTA of 2,425 days. Under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. § 1.702(a), Applicant is entitled to 1,834 days of adjustment for “A delay”. Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.702(b), Applicant is entitled to an additional 2,017 days of adjustment for “B delay”. Under 35 U.S.C. § 154(b)(2)(A) and 37 C.F.R. § 1.703, this adjustment is reduced by 1,165 days, or stated another way, the Applicant is entitled to 669 days of adjustment for non-overlapping “A delay”. Under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704, this adjustment is further reduced by 261 days. Accordingly, **the total PTA should be 2,425 days** (i.e., 1,834 days plus 2,017 days minus 1,165 days minus 261 days; or 669 days plus 2,017 days minus 261 days). The calculations for the above adjustments are discussed further below.

The Federal Circuit recently affirmed the holding of the U.S. District Court for the District of Columbia that patentees are entitled to PTA under both 35 U.S.C. 154(b)(1)(A) and 154(b)(1)(B), as long as no day is counted twice. *See Wyeth v. Dudas*, 88 USPQ2d 1538 (D.D.C. 2008), *aff’d*, No. 09-1120, slip op. at 14 (Fed. Cir. Jan. 7, 2010). The *Wyeth* court explained that the only way that the periods of time specified by Sections 154(b)(1)(A) and (B) can overlap is if they occur on the same day. *Id.* at 1541. The court further explained that the “‘B delay’ [35 U.S.C. § 154(b)(1)(B)] begins when the PTO has failed to issue a patent within three years, not before.” *Id.*

The subject application was filed on July 5, 2001. Thus, in Applicant’s case, the “B delay” began on July 5, 2004. The “A delay” (i.e., 35 U.S.C. § 154(b)(1)(A)) that Applicant is entitled to accrued in the period between July 5, 2001, and January 12, 2010. There are 852 days of “B delay” that do not overlap the “A delay” from July 5, 2004 until the issue date of January 12, 2010. Accordingly, under controlling case law, Applicant is entitled to the sum of the “A delay” and non-overlapping “B delay,” reduced by any amount specified in 35 U.S.C. § 154(b)(2)(C). As calculated below, this adjusted total is 2,425 days.

II. The Relevant Dates Specified In 37 C.F.R. §§ 1.703(a)-(e)

Under 35 U.S.C. § 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), Applicant is entitled to an adjustment of 1,491 days. Under 37 C.F.R. § 1.703(a)(1), Applicant is entitled to an adjustment of the number of days in the period beginning on the day after the date that is fourteen months after the date on which the application was filed and ending on the date of mailing of an action under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151, whichever occurs first. The subject application was filed on July 5, 2001. Fourteen months from that date was September 5, 2002. A Requirement for Restriction and Election was mailed on October 5, 2006. Thus, the number of days under § 1.703(a)(1) is 1,491 days.

Under 35 U.S.C. § 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(2), Applicant is entitled to an additional adjustment of 343 days. Under 37 C.F.R. § 1.703(a)(2), Applicant is entitled to an adjustment of the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. § 132, or a notice of allowance under 35 U.S.C. § 151, whichever occurs first. A response after non-final action was entered on August 7, 2007. The next action by the USPTO was a non-final rejection mailed on November 10, 2008. Thus, the number of days under § 1.703(a)(2) is 343 days.

37 C.F.R. § 1.703(a)(3)-(6) do not apply as of the filing of this Application for Patent Term Adjustment.

Under 35 U.S.C. § 154(b)(1)(B) and 37 C.F.R. § 1.703(b), Applicant is entitled to an additional adjustment of 2,017 days. Specifically, under 37 C.F.R. § 1.703(b), Applicant is entitled to an adjustment of the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed and ending on the issue date of the patent. Three years after the date on which the subject application was filed was July 5, 2004. The resulting patent issued on January 12, 2010. Thus, the number of days under § 1.703(b) is 2,017 days.

37.C.F.R. §§ 1.703(c)-(e) do not apply.

Under 35 U.S.C. 154(b)(2)(A) and 37 C.F.R. § 1.703(f), the term of a patent entitled to adjustment under § 1.702 and § 1.703 shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) to the extent that such periods are not overlapping. A portion of the adjustment under 37 C.F.R. § 1.703(a) overlaps with the adjustment under 37 C.F.R. § 1.703(b). Thus, Applicant is only entitled to those periods that do not overlap.

The portion of adjustment under § 1.703(a) that does not overlap with the adjustment under § 1.703(b) is the adjustment for the period beginning on the day after fourteen months from the filing date and the three-year date after the filing of the application. Fourteen months from the filing date was September 5, 2002. The three-year date after the filing of the application was July 2, 2004. Therefore, Applicant is entitled to an adjustment of 669 days for the delay under § 1.703(a). Applicant is also entitled to the entire 2,017 days of adjustment under § 1.703(b). However, Applicant is not entitled to the delay under 37 C.F.R. § 1.703(a)(2) of 343 days, which overlaps with the B-type delay. Therefore, Applicant is entitled to a total adjustment of 2,686 days (i.e., 669 days plus 2,017 days) under 35 U.S.C. 154(b)(1) and 37 C.F.R. § 1.703.

III. The Patent Is Not Subject To A Terminal Disclaimer

The above-referenced patent that is the subject matter of this request is not subject to a terminal disclaimer.

IV. The Reduction In PTA Due To 37 C.F.R. § 1.704

Under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704(b), the PTA is reduced by the number of days in excess of three months in responding to an office action. Under 37 C.F.R. § 1.704(c)(8), if a supplemental reply or other paper is submitted after a reply has been filed, the period of adjustment set forth in § 1.703 is reduced by the number of days beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

A non-final office action was mailed on January 25, 2007, to which Applicant responded on April 27, 2007. A notice of non-responsive amendment was subsequently mailed on July 26, 2007. Thereafter, Applicant filed a compliant response to non-final action on August 7, 2007.

The time in excess of three months for this response was 104 days. An information disclosure statement was subsequently filed on October 31, 2007, for an additional 85 days of delay.

A second non-final office action was mailed on November 10, 2008, to which Applicant responded on February 17, 2009. The time in excess of three months for this response was 3 days. An information disclosure statement was subsequently filed on April 27, 2009, for an additional 69 days of delay. There are no other reductions in adjustment that apply. Thus, the total reduction to PTA should be 261 days.

CONCLUSION

Applicant respectfully requests reconsideration of the PTA and a determination that **Applicant is entitled to 2,425 days of PTA** - i.e., (669 days under § 1.703(a) plus 2,017 days under § 1.703(b) minus 261 days under §§ 1.704(b) and (c)).

* * * * *

It is believed that no additional fees are due except for the fee set forth in 37 C.F.R. § 1.18(e); however, should any additional fees be required, or credits be due, the Commissioner is authorized to deduct the fees from, or credit the overpayments to, the Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000290USPT.

Respectfully submitted,

Dated: March 11, 2010

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